

REMARKS

Further consideration of the application is respectfully requested.

In the action of April 8, 2004, the examiner rejected claims 1-10 under 35 USC §112, first paragraph relative to the written description requirement; rejected claims 1-10 under 35 USC §112, first paragraph, relative to the enablement requirement; rejected claims 2-10 under 35 USC §112, second paragraph, as being indefinite; rejected claims 1-3, 5 and 10 under 35 USC §102 as anticipated by German document No. 3734127 or, alternatively, as obvious under 35 USC §103 over the '127 document in view of U.S. Patent No. 5,323,823 to Kopras or 5,143,490 to Kopras; rejected claims 1-5 and 9-10 under 35 USC §102 as anticipated by U.S. Patent No. 3,942,411 to Gerber or, alternatively, under 35 USC §103 as obvious over Gerber in view of Kopras '823 or Kopras '490; rejected claims 4 and 7-9 and alternatively, claim 10, under 35 USC §103 as unpatentable over the German '127 document or, alternatively, as obvious over the '127 document in view of Kopras '823 or Kopras '490; rejected claims 7-8 and alternatively, claim 10 under 35 USC §103 as unpatentable over Gerber or, alternatively, as obvious over Gerber in view of Kopras '823 or Kopras '490; rejected claim 6 under 35 USC §103 as unpatentable over the German '127 document in view of Kopras '823 or Kopras '490 and further in view of U.S. Patent No. 3,786,846 to Mehring; and rejected claim 6 under 35 USC §103 as unpatentable over Gerber or Gerber in view of Kopras '823 or Kopras '490 and further in view of Mehring.

Applicant has amended claim 1, which will be the focus of the following remarks concerning patentability of the invention. First, applicant respectfully traverses the examiner's rejection of claims 1-10 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The required support under 35 USC §112, first paragraph, for the limitation "substantially no openings therein which would allow air into the interior of the attachment during operation of the power tool other than the opening for the spiral saw" is provided by the description of the attachment portion as being a cylindrical section as well as Figures 1 and 2 of the drawings. A cylindrical section is a portion of a cylinder, in this case a hollow cylinder. A cylinder is normally and commonly understood as having a continuous cylindrical surface, unless otherwise specified. Engineering textbooks, including texts

relative to engineering drawings, indicate that cylinders have continuous surfaces, i.e. without openings. In illustrations of cylinders in such texts, a cylinder is always shown with a continuous cylindrical surface.

Figures 1 and 2 show the complete attachment portion. Note that there are no openings. Figure 1 is a side elevational view, while Figure 2 is a cross-sectional view. Hence, all of the surfaces of the attachment portion are illustrated in the drawings. There are no openings shown in the attachment portion. Hence, the combination of the drawings and the normal understanding of a cylindrical section would certainly indicate to one skilled in the art that there are no openings in the attachment portion. Hence, there is adequate support in the description for the limitation and the rejection of the claims under 35 USC §112, first paragraph, relative to the written description requirement, should be withdrawn.

Applicant also traverses the examiner's rejection of claims 1-10 under 35 USC §112, first paragraph, relative to the enablement requirement. The examiner asserts that the fact that there are no openings in the cylindrical section would result in the article not functioning. As is fully and carefully described, the spiral saw penetrates the workpiece during operation. Air is drawn from the other side of the workpiece through the opening created by the spiral saw. This provides the airflow for proper functioning of the device. No openings in the attachment are necessary or desired; in fact, as indicated above, it is important that there are no openings in the attachment portion which could allow air into the attachment portion during operation. If one skilled in the art follows the teaching of the patent application, the device will work properly. This satisfies the enablement requirement of 35 USC §112, first paragraph. The examiner's rejection of claims 1-10 on that basis hence should also be withdrawn.

Relative to the examiner's rejection of claims 2-10 under 35 USC §112, second paragraph, the claims have been amended to satisfy the examiner's objection. Withdrawal of that objection is also requested.

Applicant traverses the examiner's rejection of the claims under 35 USC §102/103 over the '127 German document and/or the combination of the German document with Kopras '829, Kopras '490 and Mehring. Applicant's claims specifically now state that there are no openings in the attachment portion to permit entry of air into the interior of the attachment portion. Further, applicant's

claims now state that the forward edge of the attachment portion is continuously flat and in a single plane.

Still further, claim 1 has been amended to state that the interior diameter of the attachment portion is more than twice the diameter of the spiral saw.

The '127 German reference has openings in its attachment portions, clearly different than applicants' claimed structure. Further, the forward edge of the German device is not continuously flat, nor is it in a single plane, because of openings 23 defined in the lower edge thereof, again different than the claimed structure.

Hence, there are significant structural differences between applicant's claimed invention and the '127 German reference. These structural difference are quite significant functionally. If the lower edge of applicant's attachment had openings like the '127 German reference, a large amount of dust would escape from applicant's attachment portion during operation, defeating the purpose of applicant's invention.

Applicant notes the examiner's statements with respect to the word "substantially". While applicant's attorney disagrees with the examiner's expansive interpretation of "substantially" such that the openings in the German reference were interpreted to meet the overall limitation, the word "substantially" has been eliminated, without giving up any scope of interpretation of the language now presented.

With respect to Gerber, the examiner attempts to stretch the teaching of that reference. Applicant's claims (claim 1) has been amended to reflect that the interior diameter of the attachment portion is at least twice as great as the diameter of the saw, leaving a substantial open space between the interior surface of the forward edge of the attachment portion and the spiral saw. There is virtually no open space between the saw of Gerber and the interior surface of the surrounding Gerber member. The Gerber device is designed to deal with chips of sheared material rather than dust. The Gerber "close-fitting" opening between the saw blade and the surrounding element would quickly clog with dust when used with sheetrock, for instance. The Gerber structure would be inoperable in applicants' claimed device. Claim 1 is thus patentable over Gerber and/or any combination of Gerber with any of the other references.

In summary, claim 1 specifies a structure which differentiates applicant's invention relative to the primary references of the '127 German document and Gerber. The structures taught by the '127 German document and Gerber are incapable of

removing large quantities of dust during cutting operations. Hence, both structurally and functionally, applicant's invention is patentably distinguished from the references. Allowance of the application is thus respectfully requested.

Respectfully submitted,
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